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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------------|-----------------------------|
| 10/676,378 | 09/30/2003 | Peter Schwarze | 13914-023001 / 2003P00069 | 3243 |
| 32864 7590 09/17/2009 FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022 | | | EXAMINER DUNHAM, JASON B | |
| | | | ART UNIT 3625 | PAPER NUMBER |
| | | | NOTIFICATION DATE 09/17/2009 | DELIVERY MODE ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/676,378 | Applicant(s) SCHWARZE ET AL. | |
| | Examiner JASON B. DUNHAM | Art Unit 3625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-15,17-29 and 31-42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-15,17-29 and 31-42 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 2, 2009 has been entered. Applicant amended claims 1, 3-12, 14-15, 17-26, 28-29, and 31-42. Claims 1, 3-15, 17-29, and 31-42 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15 and 17-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Independent claim 15 recites "a machine readable storage medium comprising processor-executable program instructions that when executed by a processor....", this embodiment of an article does not have support in the specification.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-8, 15, 17-22, 29, and 31-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schwarzhoff (US 6,591,260) in view of Nichols (US 2003/0055652).

Referring to claim 1. Schwarzhoff discloses a computer implemented method of integrating a new source of supply into an electronic purchasing process comprising:

initiating an electronic purchasing process on a purchasing computer system having an internal contact directory of supplies and information related to suppliers, wherein the internal contact directory is hosted by a service provider of the purchasing computer system (Schwarzhoff: abstract, figure 3, and column 7, line 49 – column 8, line 36 disclosing an entity manger (i.e. internal contact directory) for managing trading partners (e.g. suppliers));

Schwarzhoff discloses the above but does not expressly disclose a user interface. Nichols discloses a method of integrating suppliers into an electronic purchasing process including:

providing, as part of the initiated electronic purchasing process, a sourcing graphical user interface on a display device of the purchasing computer system, the sourcing graphical user interface having a first area to enter, as a source of supply in

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the electronic purchasing process, a supplier including in the internal contact directory, the sourcing graphical user interface further having a second area to initiate a search for additional suppliers not included in the internal contact directory, the second area including a listing of at least one external contact directory of suppliers, each of the at least one external contact directory being hosted by an external service provider that is not the service provider of the purchasing computer system and the internal contact directory (Nichols: figures 1 and 10 disclosing public and private directories for trading partners available via a GUI). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have combined the known method disclosed by Schwarzhoff disclosing an entity manager for managing trading partners with the known method of a GUI for managing business suppliers disclosed by Nichols because it is merely combining known techniques to yield a predictable result. Such combination is rendered obvious under KSR. See KSR, 127 S.Ct. at 1741, 82 USPQ2d at 1396.

The examiner notes that the "areas" of the UI are merely directed towards the display of data and where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability. The critical question is whether there exists any new and unobvious functional relationship between the printed matter and the substrate- In re Gulack, 217 USPQ 401 (Fed. Cir. 1983), In re Ngai, 70 USPQ2d (Fed. Cir. 2004), In re Lowry, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.01 II

upon receiving a user selection of one of the listed at least one external contract directory, establishing electronic communication, by the purchasing computing system,

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with the selected external contact directory, and receiving information from the selected external contact directory to provide, on the display device of the purchasing computing system, a display of a directory of the suppliers in the selected external contact directory (Schwarzhoff: figure 3, elements 306 LDAP lookup service and 308 directory service disclosing searching a directory distinguished names (e.g. trading partner name));

upon receiving, at the purchasing computing system, a user selection of one of the suppliers included in the selected external contact directory, sending an electronic request from the purchasing computing system and to the selected external contact directory, the electronic request identifying the selected supplier (Schwarzhoff: figure 3, and column 7, line 49 – column 8, line 36);

and in response receiving an electronic response that includes predefined required information to create in the internal contract directory for a contract entry for the selected supplier (Schwarzhoff: figure 3, and column 7, line 49 – column 8, line 36 disclosing the distinguished names of trading partners including common name, organization unit, organization name);

creating, using the information from the electronic response, a new contact entry in the internal contact directory, the new contact entry for the selected supplier (Schwarzhoff: figure 3, and column 7, line 49 – column 8, line 36 disclosing trading partners as contacts); and

assigning the selected supplier as a source of supply in the electronic purchasing process (Schwarzhoff: column 7, line 49 – column 8, line 36 disclosing facilitating transactions between trading partners).

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Referring to claim 3. The combination of Schwarzhoff and Nichols further discloses a method wherein said creating of the new contact entry comprises mapping parsed information from the electronic response into fields according to a partner interface protocol (Schwarzhoff: figure 3, and column 7, line 49 – column 8, line 36).

Referring to claims 4-5. The combination of Schwarzhoff and Nichols further discloses a method of sending information received from selected external contract directories comprising html or xml pages (Schwarzhoff: abstract and column 4, lines 16-39).

Referring to claims 6-8. The combination of Schwarzhoff and Nichols further discloses a method wherein comprising:

- The electronic purchasing process requires a supplier contact (Schwarzhoff: abstract and figure 1).
- Completing the electronic purchasing process with the new contact entry (Schwarzhoff: abstract disclosing conducting commercial transactions).
- Generating a purchase order using the new contact entry (Schwarzhoff: figure 2);

Referring to claims 15, 17-22, 29, and 31-36. Claims 15, 17-22, 29, and 31-36 are rejected under the same rationale set forth above as the combination of Schwarzhoff and Nichols discloses systems and mediums for enabling the method claims 1-3 and 6-8.

Claims 9-14, 23-28, and 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Schwarzhoff and Nichols in view of Stone (US 2002/0107889).

Referring to claims 9-14, 23-28, and 37-42. The combination of Schwarzhoff and Nichols discloses all of the above as noted above but does not expressly disclose flagging documents while determining authority. Stone discloses a method comprising:

- Determining whether a user who initiated and is controlling the electronic purchasing process has authority to approve the new contact entry (Stone: abstract and paragraph 49).
- Flagging the new contact entry as incomplete in response to determining the user does not have said authority (Stone: paragraphs 34 and 45-49). The examiner notes that Stone discloses directing reports to persons who have the proper authority.
- Generating a purchasing document with said new contact entry and flagging the purchase document as on hold (Stone: figure 1 and paragraph 54). The purchase document would be on hold till the proper person with authority authorizes the order.
- Determining an authorized approver for the new contact entry (Stone: abstract and paragraph 49).
- Generating an approval workflow item for the authorized approver (Stone: figure 3 and paragraph 52).

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- Deleting the new contact entry from the internal directory in response to the authorized approver not approving the new contact entry (Stone: paragraphs 34 and 46). Stone discloses flagging non-removable attributes, inherently Stone would allow authorized approvers (such as the head of purchasing in paragraph 54) to delete removable entries.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to have modified the combination of Schwarzhoff and Nichols to have included flagging documents while determining authority, as taught by Stone, in order to determine access authorization and routing information for data transmitted from partners (Stone: paragraphs 23 and 29). Claims 23-28 and 37-42 are rejected under the same rationale set forth above.

Response to Arguments

Applicant's arguments filed July 2, 2009 with respect to the above claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that Schwarzhoff does not disclose "establishing electronic communication, by the purchasing computing system..." as recited in claim 1. The examiner disagrees as Schwarzhoff discloses buyer and seller sites connected to transaction and directory servers for determining trading partners (see at least figure 1). Applicant further argues that Schwarzhoff does not disclose receiving a user selection of a supplier in an external directory and creating a new entry in an internal directory. The examiner disagrees as Schwarzhoff discloses trading partners (e.g. users)

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operating servers and exchanging electronic documents (e.g. partner information) when engaged in a transaction. Trading partners must inherently select the other business in order to be engaged in a transaction.

Independent claims 1, 15, and 29 as well as their respective dependents are rejected under this rationale.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure is cited on the PTO-892 form: Beisty and Clark.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JASON B. DUNHAM whose telephone number is (571)272-8109. The examiner can normally be reached on M-F, 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jason B Dunham/ 9/4/09
Primary Examiner, Art Unit 3625